

Application No. 10/693,111
Art Unit: 3712
Doll Accessories 3165 P 067

REMARKS

Summary of the Action

In the Office Action, the Examiner rejected claim 3 under 35 U.S.C. § 112 for insufficient antecedent basis. Amended claim 3 now has appropriate antecedent basis, and Applicant respectfully requests withdrawal of this rejection. Claims 1-5, 7-10, and 18-20 stand rejected under 35 U.S.C. § 103(a) as obvious in light of the cited prior art. Applicant respectfully traverses each of these rejections according to the arguments presented below. The Office Action Summary indicated that claims 12-20 were rejected, however, claims 12-16 were not explicitly rejected within the Detailed Action. Applicant respectfully submits claims 12-16 are also in a condition for allowance for the reasons set forth below.

Rejections under 35 U.S.C. § 103(a)

The Examiner rejected Claims 1-5, 7-10, and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over Norman et al. (US 6227930). Applicant respectfully traverses these rejections.

As an initial point, the Examiner failed to cite a single reference that teaches the use of a polymeric material such as that of independent claims 1, 10, and 15. Specifically, each of these rejected independent claims requires an article molded from a polymeric material having a 100% modulus of greater than 220 psi (1517 kNm⁻²). This element is not taught or suggested by the cited prior art. Instead, the Examiner made the bare statement that providing such a polymeric material having this characteristic would be considered obvious to one of ordinary skill in the art, but did not cite to any supporting prior art. Because each and every element of claims 1, 10, and 15 has not been shown within the cited prior art, these claims should be allowable.

Claims 2-5 and 7-9 ultimately depend from claim 1, and claims 18-20 ultimately depend from claim 15. These dependent claims necessarily incorporate each of the elements of the base claims, and should also be allowable.

Norman et al. discloses a doll having garments made of a polymeric material. However, the characteristics of the polymeric material of Norman et al. are markedly different from the

characteristics of the material as present in claims 1-5, 7-10 and 18-20. Norman et al. utilizes a polymer wherein the preferred 100% modulus of elasticity is between 240 and 280 kNm⁻². (Col. 1, lns. 39-45). Norman et al. continues by stating that difficulties in molding detail and in removal of the molded garments from the mold have been observed to occur with highly elastic polymers. (Col. 1, lns. 45-50). In this way, Norman et al. teaches away from using a material having characteristics as claimed by the Applicant in claims 1-5, 7-10, and 18-20.

As previously stated, Applicant claims a toy comprising a polymeric material having a 100% modulus of elasticity in excess of 220 psi (1517 kNm⁻²). Use of such a highly elastic polymer is not taught or suggested by Norman et al. Indeed, Norman et al. explicitly teaches away from the use of such a highly elastic polymer. Because Norman et al. teaches away from the use of a highly elastic material, Norman et al. cannot be properly construed as teaching one of ordinary skill in the art the modification of the cited reference into Applicant's claimed invention. For this reason, the rejection of claims 1-5, 7-10, and 18-20 should be withdrawn.

Applicant respectfully traverse the rejection of dependent claims 4 and 5 of the present application for an additional reason. Claims 4 and 5 claim the additional elements of including "a chlorinated olefin" and "a melt-processible rubber," respectively. The Examiner has taken Official Notice of the equivalence of chlorinated olefins and melt-processible rubber with other polymeric materials for use in the moldable plastics art. Applicant traverses such a rejection.

In order for the Examiner to properly take Official Notice unsupported by documentary evidence, "the facts asserted to be well-known, or to be common knowledge in the art [should be] capable of instant and unquestionable demonstration in being well-known." (MPEP § 2144.03A). That is clearly not the case in this instance. The unique properties inherent in the wide variety of moldable materials used in the plastics art makes it highly improbable that a perfunctory determination of equivalence between chlorinated olefins, melt-processible rubbers, and all other polymeric materials, could be made. In view of the above traverse, and pursuant to MPEP § 2144.03, the Examiner is obligated to provide some reference or evidence to support this rejection.

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Claim 17 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Norman et al. in view of Shannon (US 5310378). Claim 17 ultimately depends from claim 15, and includes the element of a doll accessory formed of a “polymeric material having a 100% modulus of greater than 220 psi (1517 kNm⁻²).” As discussed above, Norman et al. does not teach or suggest this element. Shannon does not remedy this deficiency in the Norman et al. reference. Therefore, for the same reasons discussed above with respect to claim 15, claim 17 is also in a condition for allowance.

Claims 12-16

Claims 12-16 were indicated as rejected on the Office Action Summary, but were not specifically addressed within the Detailed Action. Each of claims 12-16 includes within the claim either directly (claim 15), or through dependency (claims 12-14 and 16) an element not taught or suggested by any of the cited prior art. Specifically, each of claims 12-16 includes “a polymeric material having a 100% modulus of greater than 220 psi (1517 kNm⁻²).” The previously presented arguments apply with equal force to these claims, and each is in a condition for allowance.

Allowable Subject Matter

The Examiner has indicated that claims 6 and 11 contain allowable subject matter and would be allowable if rewritten in independent form. Applicant acknowledges the objection to claims 6 and 11, and reserves the right to amend these claims dependent upon further review of the allowability of the underlying base claims 1 and 10, respectively.

Conclusion

In view of the foregoing, Applicants submit that the claims are in condition for allowance, and respectfully request notice of the same.

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Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: BOX NON-FEE AMENDMENT, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 25, 2004.

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